

REMARKS

In the Office Action, the Examiner rejected claims 1, 2, 4-9, 11-14, 26 and 27. In this paper, Applicants amended independent claims 1, 7, 13, 26, and 27. Upon entry of the amendments, claims 1, 2, 4-9, 11-14, 26 and 27 remain pending in the present patent application. Accordingly, Applicants respectfully request reconsideration and allowance of all pending claims in view of the foregoing amendments and the following remarks.

Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1, 2, 4, 6-9, and 12-14 under 35 U.S.C. §102(e) as anticipated by Bydalek (U.S. Pat. No. 6,435,791). Applicants respectfully traverse this rejection. As discussed in detail below, the cited reference does not anticipate the foregoing claims.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

Independent Claim 1

Amended independent claim 1 recites, *inter alia*:

an internally threaded fastener disposed adjacent to the washer portion and retained rotatably within assembly with the stemmed washer by the retaining portion, wherein the internally threaded fastener is adapted to engage an externally threaded fastener having a shaft insertable through the standoff portion and having a head *abutable against an end of the standoff portion* opposite the washer portion, such that *the standoff portion limits compressive loading by the internally and externally threaded fasteners on the material therebetween.*

(Emphasis added).

The Bydalek reference does not disclose each and every element of amended independent claim 1. Specifically, the Bydalek reference fails to disclose a “standoff portion” as recited in claim 1. First, the Bydalek reference does not disclose a standoff portion that is abutable against a fastener head. Second, the Bydalek reference does not disclose a standoff portion that limits compressive loading by internally and externally threaded fasteners on material therebetween.

In view of these omitted features, the Bydalek reference cannot anticipate independent claim 1 or its dependent claims. Accordingly, the Applicants respectfully request the Examiner withdraw the rejection of claims 1, 2, 4, and 6 under 35 U.S.C. § 102(e).

Independent Claim 7

Turning to the next independent claim, amended claim 7 recites, *inter alia*:

a standoff portion having a substantially cylindrical structure extending from the washer portion to an end, and a retaining skirt portion extending integrally from the washer portion and capturing the peripheral flange of the threaded nut to retain the threaded nut rotatably in assembly with the base, wherein the standoff portion is adapted to receive a shaft of a threaded fastener securable to the

threaded nut such that *a portion of the threaded fastener abuts the end of the standoff portion to substantially limit compressive loading on a material.*

(Emphasis added).

The Bydalek reference does not disclose each and every element of amended independent claim 7. Primarily, Bydalek fails to disclose a standoff portion having an end that abuts a threaded fastener to limit compressive loading on a material. Additionally, Bydalek clearly does not disclose standoff portion having a substantially cylindrical structure extending from the washer portion to an end.

For these reasons, the Bydalek reference cannot anticipate independent claim 7 or its dependent claims. Accordingly, the Applicants respectfully request the Examiner withdraw the rejection of claims 7-9 and 12 under 35 U.S.C. § 102(e).

Independent Claim 13

Amended independent claim 13 recites, *inter alia*:

a base having a washer portion with an abutment surface adapted to abut an outer surface of a material, a standoff portion adapted to extend from the washer portion such that the standoff portion extends substantially through the material to *an abutment end of the standoff adapted to limit displacement of the externally threaded fastener relative to the washer portion*, and a retaining skirt portion extending integrally from the washer portion and capturing the internally threaded fastener rotatably in assembly with the base.

(Emphasis added).

The Bydalek reference does not disclose each and every element of amended independent claim 13. Specifically, the Bydalek reference does not disclose a standoff as recited in claim 13. First, the Bydalek reference does not disclose a standoff. Second, the

Bydalek reference does not disclose a standoff adapted to limit displacement of an externally threaded fastener relative to a washer portion.

In view of these deficiencies, the Bydalek reference cannot anticipate independent claim 13 or its dependent claims. Accordingly, the Applicants respectfully request the Examiner withdraw the rejection of claims 13 and 14 under 35 U.S.C. § 102(e).

Rejections Under 35 U.S.C. §103

Under 35 U.S.C. § 103(a), the Examiner rejected claims 1, 2, and 4-6 as unpatentable over Hans (U.S. Pat. No. 3,829,163) in view of Bydalek; claims 1, 2, and 4-6 as unpatentable over Goiny (U.S. Patent No. 4,969,788); claims 5 and 11 as unpatentable over Bydalek in view of Goiny; and claims 26 and 27 as unpatentable over Bydalek in view of Hans. Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App & Inter. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); M.P.E.P. § 2143.01.

Rejection of claims 1, 2, 4-6, 11, 26, and 27 under Section 103(a)

Applicants assert that, as discussed in detail above regarding the Bydalek reference, none of the cited references either alone or in combination discloses each and every element of amended independent claims 1, 7, 26, or 27. Specifically, none of the references cited by the Examiner either alone or in combination discloses a standoff as recited in each respective amended independent claim. In view of these deficiencies, the cited references cannot render obvious amended independent claims 1, 7, 26, and 27 or their respective dependent claims. Accordingly, the Applicants respectfully request the Examiner withdraw the rejection of claims 1, 2, 4-6, 11, 26, and 27 under 35 U.S.C. § 103(a).

Rejection of Claims 1, 2, 4-6, 26 and 27 over Hans-Bydalek Combination

In addition to the failure to disclose each and every element of the amended independent claim as discussed above, Applicants assert that one skilled in the art would not be compelled, or find it obvious, to combine the teachings of the two references, i.e., Hans and Bydalek. In fact, the Hans-Bydalek combination would change the principle of operation of each respective reference. For this reason, the Hans-Bydalek combination is improper and cannot stand.

Turning to the references, Hans teaches a lug nut 2 having a pyramid-shaped end 2, which is *glued* to a conical receiving section 5 within a wheel sleeve 4. *See* Hans, Fig.

1; Column 1, lines 41-58; Column 2, lines 26-30 and 57-65. Hans further teaches that, during mounting of a wheel 14 onto a wheel hub 15, the axial force between stud 10 and the lug nut 1 breaks contact with the glue to facilitate tightening onto the hub 15. *See* Hans, Figs. 2 and 3; Column 2, lines 57-65. Even the claims recite, “a weak glue.” Hans, col. 4, line 9. Thus, the *principle of operation* of Hans requires a *glued interface* between the lug nut 2 and conical receiving section 5.

In stark contrast, the Bydalek reference, as discussed above, discloses a bolt 12 having a flange 22 and a pressure ring 16 having a flange 32, which has a crimp 54 that overlaps the flange 22 of the bolt 12. *See* column 2, lines 48-61. In this manner, the crimp 54 prevents separation of the bolt 12 from the pressure ring 16, while preserving a degree of play with respect to the longitudinal axis. *See id.* Thus, the *principle of operation* of Bydalek requires *freedom of movement* in an *inseparable assembly* of the bolt 12 and pressure ring 16. *See id.* This freedom of movement of Bydalek is impossible with the glued interface of Hans. *See id.*

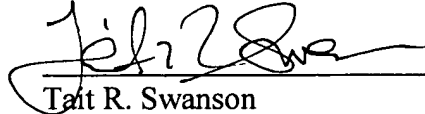
In view of these incompatible principles of operation and the foregoing legal precedent, the proposed Hans-Bydalek combination is improper and cannot stand. Accordingly, the Applicants respectfully request the Examiner withdraw the rejection of claims 1, 2, 4-6, 26, and 27 under 35 U.S.C. § 103.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Applicants kindly invite the Examiner to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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Tait R. Swanson
Registration No. 48,226
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545